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Intellectual Property Department
170 Wood Avenue South
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EXAMINER

MIRZADEGAN, SAEED S

ART UNIT	PAPER NUMBER
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2144

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01/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,059

Applicant(s)

PASTRO ET AL.

Examiner

Saeed S. Mirzadegan

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Action is in regards to the Response received on 23 November 2007.
2. Applicant's Amendments, (see Amendments to Drawings filed 23 November 2007) with respect to the Drawings have been fully considered and are persuasive. The Objections to the Drawings have been withdrawn.
3. Applicant's Amendments with respect to claims 11 and 41 have been fully considered and are persuasive. The claim objections have been withdrawn.
4. Applicant's Amendments with respect to claims 4, 10, 17 and 35 rejection under 35 U.S.C. 112 2nd have been fully considered and are persuasive. The 35 U.S.C. 112 2nd Rejections have been withdrawn.
5. Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the following ground(s) of rejection.

Claim Objections

6. Claims 4, 10, 17, 35, 40, 42 are objected to because of the following informalities: Acronyms are used without proper explanation.
7. Claims 4, 10, 17, 35, 40, 42 recite "SIP" where it should read "Session Initiated Protocol (SIP)"; "CSTA" where it should read "Computer Supported Telephony Application (CSTA)"; "IM" where it should read "Instant Messaging (IM)".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 17 is rejected under 35 U.S.C. 101 because as recited, claim 17 does not fit any of the statutory conditions of 101. That being: a new and useful process, machine, manufacture, or composition of matter. Claim 17, lines 1-2 recite "converting step also converts said CSTA device to a SIP device". As recited, applicant implies that physical devices are converted from one form to another form.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claims 1-22, 24, 28-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz et al. (Wengrovitz) US PG Pub. No. 2004/0205209, in view of Chavez et al. (Chavez) US PG Pub. NO. 2005/0013421.

13. Regarding **Claim 1**, Wengrovitz discloses, an apparatus comprising:

- a. a first device **(Fig. 1, 16) Sip set utilizing SIP protocol;**
- b. a second device implementing a second protocol **(Fig. 1, 12) Digital Set utilizing PDSV protocol;**
- c. a protocol converter to convert between said first protocol and said second protocol **(Fig. 1, 26) Protocol Converter;**
- d. a register to register said first device and said second device **(Fig. 1, 18) & (Fig. 5B) & (Page 4, ¶0067) SIP-PBX proxy server, registers the first device and the second device;**
- e. a map to map a first client to said first device and a second client to said second device **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client.**

14. However Wengrovitz does not explicitly teach: at least one of said first device and said second device is a telephone set with a keypad having a fixed number of key buttons and a display; full IM capability is provided to said telephone set.

15. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0035, lines 9-11) using a phone to compose and display instant messages using its key buttons and display (¶0022, lines 1-17) full IM capability.**

16. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message plus full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages **(see Chavez, abstract, lines 2-4)**. Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

17. Regarding **Claim 2**, Wengrovitz-Chavez disclose the invention substantially as claimed. Wengrovitz further discloses said first protocol is a Session Initiation Protocol (SIP) **(Fig. 1, 16) Sip set utilizing SIP protocol.**

18. Regarding **Claim 3**, Wengrovitz-Chavez as applied to claim 2 above disclose the invention substantially as claimed. Wengrovitz further discloses said second protocol is a Computer Supported Telephony Application (CSTA), **(Fig. 29, ¶0113, lines 1-4) Computer Supported Application (CSTA) is a supported protocol.**

19. Regarding **Claim 4**, Wengrovitz-Chavez as applied to claim 3 above disclose the invention substantially as claimed. Wengrovitz further discloses said first device is a SIP device **(Fig. 1, 16) & (Fig. 29) Sip set utilizing SIP protocol**. However Wengrovitz does not explicitly teach: managing and determining presence information for a respective IM user.

20. In the same field of endeavor, Chavez teaches, **(page 2, ¶0022, lines 1-10) managing and determining presence information for respective IM users.**

21. Same motivation applied for the combination of claim 1 applies equally as well to claim 4.

22. Regarding **Claim 5**, Wengrovitz-Chavez as applied to claim 4 above disclose the invention substantially as claimed. Wengrovitz further discloses said first device is a Personal Computer (PC) **(Fig. 29, ¶0113) the utilization of Computer Telephony Integration (CTI) which necessitates the usage of a computer (PC).**

23. Regarding **Claim 6**, Wengrovitz-Chavez as applied to claim 4 above disclose the invention substantially as claimed. Wengrovitz further discloses said first device is a Personal Digital Assistant (PDA) **(Fig. 29, ¶0113) the utilization of Computer Telephony Integration (CTI) which necessitates the usage of a PAD which is a type of computer (PC).**

24. Regarding **Claim 7**, Wengrovitz-Chavez as applied to claim 3 above disclose the invention substantially as claimed. Wengrovitz further discloses said second device is said telephone set and said telephone set is a digital telephone **(Fig. 1, 12) & (Fig. 29) Digital set**. However Wengrovitz does not explicitly teach: instant messaging being displayed on said display.

25. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0035, lines 9-11) using a phone to compose and display instant messages using its key buttons and display**.

26. Same motivation applied for the combination of claim 1 applies equally as well to claim 7.

27. Regarding **Claim 8**, Wengrovitz-Chavez as applied to claim 7 above disclose the invention substantially as claimed. Wengrovitz further discloses said digital telephone is connected through a telephonic switch **(Fig 1, 10) & (Fig. 29) IP-PBX**.

28. Regarding **Claim 9**, Wengrovitz-Chavez as applied to claim 8 above disclose the invention substantially as claimed. Wengrovitz further discloses said telephonic switch is a Private Branch Exchange (PBX) **(Fig 1, 10) & (Fig. 29) IP-PBX**. However Wengrovitz does not explicitly teach: full IM capability includes composing messages, responding to messages and creating a buddy list.

29. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0035, lines 9-11) using a phone to compose and display instant messages using its key buttons and display (¶0022, lines 1-17) full IM capability.**

30. Same motivation applied for the combination of claim 1 applies equally as well to claim 9.

31. Regarding **Claim 10**, Wengrovitz-Chavez as applied to claim 3 above disclose the invention substantially as claimed. Wengrovitz further discloses said first device is a second protocol device **(Fig. 1, 12) Digital Set utilizing PDSV protocol.**

32. Regarding **Claim 11**, Wengrovitz-Chavez as applied to claim 10 above disclose the invention substantially as claimed. Wengrovitz further discloses said first device is said telephone set and said telephone set is a digital telephone **(Fig. 1, 12) & (Fig. 29) Digital set.** However Wengrovitz does not explicitly teach: wherein at least one key button is a programmable key.

33. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0021, lines 2-11) reprogramming or redefining feature activator or the function keys on the phone indicates at least a programmable key button.**

34. Same motivation applied for the combination of claim 1 applies equally as well to claim 11.

35. Regarding **Claim 12**, Wengrovitz-Chavez as applied to claim 11 above disclose the invention substantially as claimed. Wengrovitz further discloses said digital telephone is connected through a telephonic switch monitoring said key buttons and having full control of said display **(Fig 1, 10) & (Fig. 29) IP-PBX**. However Wengrovitz does not explicitly teach: said key buttons and said display.

36. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0035, lines 9-11) using a phone to compose and display instant messages using its key buttons and display.**

37. Same motivation applied for the combination of claim 1 applies equally as well to claim 12.

38. Regarding **Claim 13**, Wengrovitz-Chavez as applied to claim 12 above disclose the invention substantially as claimed. Wengrovitz further discloses said telephonic switch is a Private Branch Exchange (PBX) **(Fig 1, 10) & (Fig. 29) IP-PBX**.

39. Regarding **Claim 14**, Wengrovitz discloses, a method comprising the steps of:

f. registering a first protocol digital telephone set **(Fig. 1, 18) & (Fig. 5B) & (Page 4, ¶0067) SIP-PBX proxy server, registers the first device and the second device;**

g. converting said first protocol to a second protocol **(Fig. 1, 26) Protocol Converter**

h. mapping a client to said digital telephone set **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client;**

i. communicating an instant message to or from said digital telephone set **(Fig. 12, 144, ¶0085, lines 7-12) an Instant message is transmitted with each key press.**

40. However Wengrovitz does not explicitly teach: including a display and a keypad having a fixed number of key buttons; instant messaging being displayed on said display and full IM capability is provided to said first protocol digital telephone set.

41. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0035, lines 9-11) using a phone to compose and display instant messages using its key buttons and display (¶0022, lines 1-17) full IM capability.**

42. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (**see Chavez, abstract, lines 2-4**). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

43. Regarding **Claim 15**, Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. Wengrovitz further discloses the steps of:

- j. registering a second device (**Fig. 1, 18**) & (**Fig. 5B**) & (**Page 4, ¶0067**) **SIP-PBX proxy server, registers the first device and the second device;**
- k. wherein said mapping step further maps a second client to said second device (**Fig. 3, 40**) **port mapping table, maps the first client to the first device and the second client to the second client** and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (**Fig. 12, 144, ¶0085, lines 7-12**) **an instant message is transmitted with each key press.**

44. Regarding **Claim 16**, Wengrovitz-Chavez as applied to claim 15 above disclose the invention substantially as claimed. Wengrovitz further discloses said second device

is a personal computer (PC) **(Fig. 29, ¶0113) the utilization of Computer Telephony Integration (CTI) which necessitates the usage of a computer (PC);** and wherein said mapping step further maps a second client to said PC **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client;** and said instant messaging includes communicating an instant message between said first digital telephone set and said PC **(Fig. 12, 144, ¶0085, lines 7-12) an Instant message is transmitted with each key press.**

45. Regarding **Claim 17**, Wengrovitz-Chavez as applied to claim 15 above disclose the invention substantially as claimed. Wengrovitz further discloses said second device is a CSTA digital telephone set **(Fig. 1, 12) Digital Set utilizing PDSV protocol;** and wherein said converting step also converts said CSTA device to SIP device **(Fig. 1, 26) Protocol Converter,** said mapping step further maps a second client to said second digital telephone set **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client** and said communicating step further includes communicating an instant message between said first and said second digital telephone sets **(Fig. 12, 144, ¶0085, lines 7-12) an Instant message is transmitted with each key press.**

46. Regarding **Claim 18**, Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. Wengrovitz further discloses, the step of configuring said at least one key button as an Instant Messaging (IM) key for a digital

telephone set (**Fig. 12, 144, ¶0085, lines 7-12**) **an instant message is transmitted with each key press**. However Wengrovitz does not explicitly teach: at least one key button is a programmable key.

47. In the same field of endeavor, Chavez teaches, (Fig. 7, ¶0021, lines 2-11) reprogramming or redefining feature activator or the function keys on the phone indicates at least a programmable key button.

48. Same motivation applied for the combination of claim 14 applies equally as well to claim 18.

49. Regarding **Claim 19**, Wengrovitz-Chavez as applied to claim 18 above disclose the invention substantially as claimed. Wengrovitz further discloses the step of establishing the IM connection by pressing said instant messaging key (**Fig. 12, 135, ¶0085, lines 4-7**) **an instant message is transmitted without a dialed number with pressing the key**.

50. Regarding **Claim 20**, Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. However Wengrovitz does not explicitly teach: sending a notification to said digital telephone set when a new instant message arrives, said digital telephone displaying a new instant message notification in response.

51. In the same field of endeavor, Chavez teaches, (**¶0084**) **ring tone notifies the user of the receipt of the message, (¶0085, lines 1-3) digital telephones displaying the text of the new IM.**

52. Same motivation applied for the combination of claim 14 applies equally as well to claim 20.

53. Regarding **Claim 21**, Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. Wengrovitz further discloses instant messaging is accomplished while the digital telephone set is off-hook (**Fig. 12, 135, ¶0085, lines 4-7**) **user is off-hook and an Instant message is transmitted without a dialed number with pressing the key.**

54. Regarding **Claim 22** Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. However Wengrovitz does not explicitly teach: instant messaging includes composing and displaying instant messages using the standard key buttons and display space of said digital telephone set.

55. In the same field of endeavor, Chavez teaches, (**Fig. 7, ¶0035, lines 9-11**) using a phone to compose and display instant messages using its key buttons and display.

56. Same motivation applied for the combination of claim 14 applies equally as well to claim 22.

57. Regarding **Claim 24**, Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. Wengrovitz further discloses instant messaging includes using said digital telephone set to sign-in and sign-out for instant messaging services (**Fig. 12, 135, ¶0085, lines 4-7) user is off-hook and an Instant message is transmitted without a dialed number with pressing the key.**

58. Regarding **Claim 28** Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. However Wengrovitz does not explicitly teach: instant messaging includes sending stored common replies to other instant messaging clients.

59. In the same field of endeavor, Chavez teaches, (**¶0086, lines 2-4) the message is saved and then sent as a response.**

60. Same motivation applied for the combination of claim 14 applies equally as well to claim 28.

61. Regarding **Claim 29** Wengrovitz-Chavez as applied to claim 28 above disclose the invention substantially as claimed. However Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field.

62. In the same field of endeavor, Chavez teaches, (**¶0086, lines 2-4**) **the stored text message is a text response created by the user.**

63. Same motivation applied for the combination of claim 14 applies equally as well to claim 29.

64. Regarding **Claim 30** Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. However Wengrovitz does not explicitly teach: instant messaging includes sending stored common messages to other instant messaging clients.

65. In the same field of endeavor, Chavez teaches, (**¶0087 & ¶0088**) **the stored text message is transmitted in response to the sender.**

66. Same motivation applied for the combination of claim 14 applies equally as well to claim 30.

67. Regarding **Claim 31** Wengrovitz-Chavez as applied to claim 30 above disclose the invention substantially as claimed. However Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field.

68. In the same field of endeavor, Chavez teaches, (**¶0022, lines 11-17**) **stored text messages are associated or mapped to key's, these messages can be customized by the user.**

69. Same motivation applied for the combination of claim 14 applies equally as well to claim 31.

70. **Claim 32** list all the same elements of claim 1, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 1 applies equally as well to claim 32.

71. **Claim 33** list all the same elements of claim 2, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 2 applies equally as well to claim 33.

72. **Claim 34** list all the same elements of claim 3, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 3 applies equally as well to claim 34.

73. **Claim 35** list all the same elements of claim 4, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 4 applies equally as well to claim 35.

74. **Claim 36** list all the same elements of claim 5, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 5 applies equally as well to claim 36.

75. **Claim 37** list all the same elements of claim 7, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 7 applies equally as well to claim 37.

76. **Claim 38** list all the same elements of claim 8, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 8 applies equally as well to claim 38.

77. **Claim 39** list all the same elements of claim 9, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 9 applies equally as well to claim 39.

78. **Claim 40** list all the same elements of claim 10, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 10 applies equally as well to claim 40.

79. **Claim 41** list all the same elements of claim 11, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 11 applies equally as well to claim 41.

80. **Claim 42** list all the same elements of claim 14, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 14 applies equally as well to claim 42.

81. **Claim 43** list all the same elements of claim 15, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 15 applies equally as well to claim 43.

82. **Claim 44** list all the same elements of claim 16, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 16 applies equally as well to claim 44.

83. **Claim 45** list all the same elements of claim 17, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 17 applies equally as well to claim 45.

84. **Claim 46** list all the same elements of claim 18, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 18 applies equally as well to claim 46.

Claim Rejections - 35 USC § 103

85. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view of Chavez further in view of Northcutt (Northcutt) US PG Pub. No. 2005/0059418.

86. Regarding **Claim 23** Wengrovitz-Chavez as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz-Chavez do not explicitly teach: sending a notification to said digital telephone set when a request to add said digital telephone set client to the contact list of another instant messaging client is received.

87. In the same field of endeavor, Northcutt teaches, **(¶0006) the users are informed when a contact list is created and is transmitted in order to upload the new client list to other users.**

88. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Northcutt's teachings of notification of uploading the client list with the teachings of Wengrovitz-Chavez, to allow groups of mobile phone users that share common contacts to effortlessly update their respective contact lists (**see Northcutt, abstract & ¶0003**). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

Claim Rejections - 35 USC § 103

89. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view of Chavez and further in view of Jerbi et al. (Jerbi) DE10127360.

90. Regarding **Claim 25** Wengrovitz-Chavez as applied to claim 14 above disclose the invention substantially as claimed. However Wengrovitz-Chavez do not explicitly teach: communicating includes using said digital telephone set to change the on-line and off-line status of said digital telephone set for instant messaging.

91. In the same field of endeavor, Jerbi teaches, (**abstract**) **the user is informed of the status of other partners for the purpose of instant messaging.**

92. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Jerbi's teachings of phone status

with the teachings of Wengrovitz-Chavez, for the purpose of providing user with partner status **(see Jerbi, title & abstract)**. Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

Claim Rejections - 35 USC § 103

93. **Claims 26, 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view Chavez and further in view of Lee (Lee) US PG Pub. No. 2005/0108348.

94. Regarding **Claim 26** Wengrovitz-Chavez as applied to claim 14 above discloses the invention substantially as claimed. However Wengrovitz-Chavez do not explicitly teach: using said digital telephone set to query the status of a contact list member.

95. In the same field of endeavor, Lee teaches, **(abstract & ¶0036, lines 4-9) user monitors the status of a contacts list or personal list of clients from the address book.**

96. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Lee's teachings of contacts list status monitoring with the teachings of Wengrovitz-Chavez, for the purpose of permitting the user to selectively control the level of status information received for each

user or endpoint in a communication group (**see Lee, ¶0007, lines 9-11**). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

97. Regarding **Claim 27** Wengrovitz-Chavez as applied to claim 14 above discloses the invention substantially as claimed. However Wengrovitz-Chavez do not explicitly teach: determining the presence status of said digital telephone based on call activity of said digital telephone.

98. In the same field of endeavor, Lee teaches, (**abstract & ¶0036, lines 4-9**) **user monitors the status of a contacts list. Since the contacts list are generated based on the call activity, therefore the status is being monitored based on the call activity.**

99. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Lee's teachings of monitoring the status based on the contacts list which itself is based on call activity with the teachings of Wengrovitz-Chavez, for the purpose of permitting the user to selectively control the level of status information received for each user or endpoint in a communication group (**see Lee, ¶0007, lines 9-11**). Wengrovitz provides motivation to do so, by converting

messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see **Wengrovitz, abstract, lines 10-12**).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed S. Mirzadegan whose telephone number is 571-270-3044. The examiner can normally be reached on M-F 8:00-5:00.

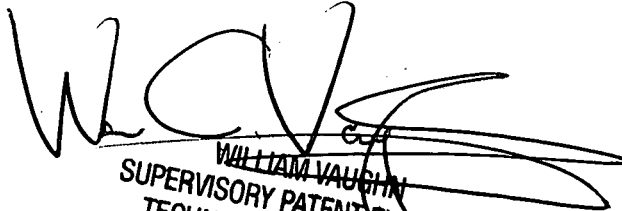
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sm


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